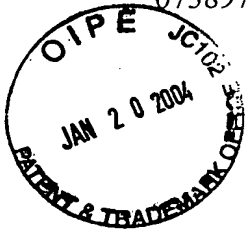


01-22-04

1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of: Eric D. Fox
Serial No. 10/650,560
Filing Date: August 28, 2003
Title: *Identification Card With Changeable Insert*

MAIL STOP: PETITIONS
Commissioner For Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

**CERTIFICATE OF MAILING
BY EXPRESS MAIL**

I hereby certify that this communication is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" under 37 C.F.R. § 1.10 on the date indicated below and is addressed to Commissioner For Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Willie Files
Willie Files

Date: January 20, 2004

Exp. Mail Receipt No. EV 323450859 US

Dear Sir:

01/26/2004 MDAMTE1 00000010 10650560

01 FC:1460

130.00 DP

Petition to Make Special Under 37 C.F.R. § 1.102(d)

Applicant submits this Petition under 37 C.F.R. § 1.102(d) to make this Application special.

Pre-Examination Search

The professional search firm Intellectual Property Concerns, Inc., has made a pre-examination search. The search included Class 283, Subclasses 77, 99, 107, 112, and 904. Foreign patents and literature were also searched. In addition, Applicant performed a

keyword search of the patent database at the United States Patent and Trademark Office website, www.uspto.gov.

The searches uncovered the following references:

1. U.S. Patent No. 3,283,713
Inventor: Earl V. Wooster
Title: *Credit Card*
2. U.S. Patent No. 3,287,839
Inventors: Joseph Rotwein and Andrew E. Friedrich
Title: *Identification Card Provided With Combination Locking Means*
3. U.S. Patent No. 3,491,471
Inventor: Harry F. Semple
Title: *Aperture Card With Loading Slit in Card*
4. U.S. Patent No. 3,810,566
Inventors: William E. Adams et al.
Title: *Personal Medical Record Carrier*
5. U.S. Patent No. 4,619,469
Inventor: Jerry D. Grover
Title: *Card for Microfilm and Method of Performing Same*
6. U.S. Patent No. 5,928,758
Inventor: Rafael R. Huguet
Title: *Blanks for Microfilm Insertions*
7. U.S. Patent No. 6,571,940
Inventor: Chris M. Newman
Title: *Flat Article Holder*
8. U.S. Patent Application Publication No. US 2002/0179463
Inventor: Chris M. Newman
Title: *Flat Article Holder*
9. U.S. Patent No. 6,050,605
Inventors: Raymond J. Mikelonis and David Crego
Title: *Wallet Card with Sleeve Adapted for Receipt of Elongated Functional Member*
10. U.S. Patent No. 3,434,414
Inventor: Lyle E. Wright
Title: *Credit Card Assembly*

11. U.S. Patent No. 5,074,593
Inventor: John Grosso
Title: *Insert Holder With Sealable Opening*
12. U.S. Patent No. 5,161,827
Inventor: John Grosso
Title: *Insert Holder with Sealable Opening*
13. U.S. Patent No. 4,202,120
Inventor: Elton D. Engel
Title: *Identification Card, Sensor, and System*
14. U.S. Patent No. 4,338,025
Inventor: Elton D. Engel
Title: *Identification Card, Sensor, and System*
15. U.S. Patent No. 3,583,317
Inventor: George W. Gibson
Title: *Two-Piece Credit Identification Cards*
16. U.S. Patent No. 3,855,033
Inventor: Henry N. Staats
Title: *Method of Making Embossable Monolithic Identification Credit Card*
17. U.S. Patent No. 4,318,554
Inventors: Thomas P. Anderson and Richard G. Bramley
Title: *Combined Medical and/or Informational Identification Credit Card*
18. U.S. Patent No. 5,746,451
Inventor: Frank M. Weyer
Title: *Customizable Credit Card Overlay*
19. U.S. Patent No. 6,224,109
Inventor: James Yung Chien Yang
Title: *Credit Card With Driver's License or Identification*
20. U.S. Patent No. 5,774,168
Inventor: Rainer Blome
Title: *Identity Card and Process for Its Production*
21. U.S. Patent No. 5,972,546
Inventor: Hans I. Bjelkhagn
Title: *Secure Photographic Method and Apparatus*
22. U.S. Patent Application Publication No. US 2001/0005953
Inventor: Herman K. Painsith
Title: *Display Frame for Photographs and the Like and Typically Credit Card-Sized*

Detailed Discussion of the References

U.S. Patent No. 3,283,713 discloses a credit card consisting of two pieces which are placed together immediately prior to use, wherein the signature of the holder, the printed name of the holder, and portions of the serial number appear on the individual pieces of the card. U.S. Patent No. 3,283,713 also discloses a two-piece credit card of the aforesaid type, wherein one piece consists of a base plate having a recess or small opening therein, and the second piece consists of a small token which can be conveniently carried in the pocket of the holder. U.S. Patent No. 3,283,713 also discloses a two-piece credit card of this type, wherein the token can be easily and releasably secured to the base plate in a minimum of time and without tools.

U.S. Patent No. 3,287,839 discloses an improved carrying card which serves to identify or symbolize the credit rating of only the true owner thereof and which is of no value to anyone other than the proper owner or holder thereof. The improved carrying card has a locking device incorporated therein which must be first unlocked before the card is validated and in condition for use. U.S. Patent No. 3,287,839 also discloses a card (such as a credit card) having a small and compact combination lock formed therein which must be first dialed to the correct combination before the face of the card can signify that the card is valid and in the possession of the rightful holder or owner thereof. U.S. Patent No. 3,287,839 also discloses an improved form of credit card with a sliding panel or pane and a locking device therefor adapted to maintain the panel in an immovable position within the card and closure until the operator releases the lock or such panel to slide the latter outwardly to validate the card.

U.S. Patent No. 3,491,471 discloses an aperture card that has transparent films affixed to each side of the card about the periphery of the aperture. At one end of the aperture, the film is longer and affixed to the card farther away from the aperture than is the film at the opposite side of the card. At the same end and between the lines of affixation of

the films is a slit through the card to give access to the aperture for the insertion of a microfilm or the like.

U.S. Patent No. 3,810,566 discloses an apparatus for carrying medical records on the person and comprises, in combination, at least one microfilm chip bearing medical indicia and a receptacle for the chip adapted for attachment to the human body to enclose and protect the chip until needed.

U.S. Patent No. 4,619,469 discloses a card for microfilm and the like including a core with a cut-out open at an edge thereof and front and back surfaces. Front and back transparent panels are bounded to the front and back core surfaces, respectively, in covering relation to the cut-out. An opaque security cover is removably secured to one of the front and back panels in covering relation over the cut-out. A pocket is formed by the cut-out between the front and back panels and is adapted to receive a microfilm segment readable through the front panel with the cover removed from the card. A method of forming the card includes heat laminating the front and back panels against the core front and back surfaces, respectively, with a microfilm segment and a spacer positioned in the pocket and removably securing the opaque cover to one of the front and back panels in covering relation over the cut-out.

U.S. Patent No. 5,928,758 discloses a card blank for identification cards and the like that includes a microfilm with predetermined information to be read by a common utensil such as a magnifying glass or a microscope. The card includes two sheets that join together at predetermined areas and include each a window with similar dimensions and in alignment. The microfilm is positioned between the two sheets exposing most of its area with information. The edges of the microfilm are sandwiched by the two sheets defining a peripheral wall around the windows. One of the embodiments contemplates the use of a slot in one of the sheets with a peripheral pocket surrounding the windows. This allows the ready insertion of the microfilm. A flexible second sheet folds back permitting a user to bring one straight edge of the microfilm in abutting contact with an interface line thereby readily

positioning the microfilm so that a substantial portion of its information is exposed. A lamination film is subsequently placed over the sheets to protect the microfilm.

U.S. Patent No. 6,571,940 discloses an article holder that includes a card body with one or more panels covering article receiving pockets formed within a core member. The holder may also be provided with an embossing zone for receiving embossed alpha numeric indicia as typically provided in transaction cards, and/or an electronically readable zone containing electronically readable media separate from an article holder zone. In a preferred form, the holder may be provided with an adhesive surface covered by a removable strip. The strip may be removed from the adhesive to permit attachment of an identification card to the holder.

U.S. Patent Application Publication No. US 2002/0179463 discloses an article holder that includes a card body with one or more panels covering article receiving pockets formed within a core member. The holder may also be provided with an embossing zone for receiving embossed alpha numeric indicia as typically provided in transaction cards, and/or an electronically readable zone containing electronically readable media separate from an article holder zone. The holder may be provided with an adhesive surface covered by a removable strip. The strip may be removed from the adhesive to permit attachment of an identification card to the holder.

U.S. Patent No. 6,050,605 discloses a wallet card comprised of front and back transparent exterior surface panels, front and back core panels, and an elongate interval sleeve. The outward-facing surfaces of the core panels bear personal medical information, and a flexible strip thermometer is stowed within the sleeve. Registering apertures are provided in the core panels. These being sized to accommodate a plurality of microfilm chips bearing further personal medical information. Thus, a display window is defined in the wallet card where through the microfilm chips may be read.

U.S. Patent No. 3,434,414 discloses a separable credit card having a major body section with raised letter printing indicia thereon, a removable clip with corresponding indicia, and a series of holders for the clip.

U.S. Patent No. 5,074,593 discloses a transparent insert holder of the type characterized by being adapted to receive and protect cards such as photographs, permits, and the like. The insert holder includes first and second four-sided plastic sheets for forming front and back sides of the insert holder and a four-sided double-sided adhesive frame for being adhesively positioned between said first and second plastic sheets for securing said first and second sheets together to form the holder. The adhesive frame defines an opening for receiving a card such as a photograph or identification card therein.

U.S. Patent No. 5,161,827 discloses a transparent insert holder of the type characterized by being adapted to receive and protect cards such as photographs, permits, and the like. The insert holder includes first and second four-edged plastic cover sheets for forming front and back surfaces of the insert holder. The first plastic cover sheet has a predetermined-sized transparent window therein defined by a surrounding non-transparent area, and a four-edged double-sided frame is provided for being positioned between the first and second plastic sheets for securing the first and second sheets to opposing front and backsides of the frame to form the holder. The frame has a pressure sensitive adhesive coating the frame on its front and back surface. The first cover sheet is secured to the frame by the pressure-sensitive adhesive to completely enclose one of the front or back surfaces of the frame. The second cover sheet is secured to the other of the front or back surfaces of the frame along a first edge segment of the frame and unattached to a second edge segment of the frame, whereby the second cover sheet is hinged to the frame to form a flat covering the frame which can be flexed away from the frame to insert a card thereunder and into the frame opening. A release liner means covers the adhesive on a second edge segment of the frame covered by the second cover sheet to protect the adhesive until assembly of the frame in the cover sheets.

U.S. Patent No. 4,202,120 discloses an identification card that displays a finger or thumbprint pattern to confirm the user's identity. The card contains a sliding transparent window that slides from a concealed, non-use position to a visible position where the user can place his fingerprint on the window. When the window slides from the visible position to the concealed position, a wiper in the card cleans a residual print from the window.

U.S. Patent No. 4,338,025 discloses an identification card, sensor, and system using fingerprint or thumbprint pattern identification to confirm the user's identity. The identification card contains a sliding transparent window concealed when the card is not in use. When the card is used, it is inserted into a sensor and the window is slid to a visible position where the user can impress his or her thumbprint or fingerprint thereon. The sensor scans the thumbprint or fingerprint and transmits the pattern to a central file for comparison with a record thumbprint or fingerprint of the individual who is authorized to use the identification card. An account number can be located on the card enabling the sensor to scan and transmit to the central file information to identify the record thumbprint or fingerprint against which the user's physical thumbprint or fingerprint is being compared. The authorized user is confirmed by an appropriate indication at the sensor while an unauthorized user is detected by another appropriate indication. Once the authorized user's identity has been confirmed, the transaction is completed; then the transparent window is returned to its concealed position. As the window is being slid to its concealed position, a wiper within the card wipes the residual print from the window. The sensor is particularly convenient for use and includes a compact scanning device and also a keyboard for entry of additional information relating to the transaction.

U.S. Patent No. 3,583,317 discloses a credit identification card used for credit purchasing and the like having a flat main portion of substantially rectangular shape with a longitudinal slot extending inwardly from the edge which is slidably engaged by a flat secondary portion of substantially the same shape as the longitudinal slot and main portion and said secondary portion being of a uniform thickness such that the opposite faces of the main and secondary portions respectively lie in the same plane when the second portion is

fitted with a longitudinal slot at the main portion. The two portions of the credit identification card have printed or embossed thereon, suitable identifying indicia that will insure a matching between the two portions of the card. The credit identification card is comprised of a flat main card provided with a flat secondary portion; the main card and the second portion being of a uniform thickness and the flat secondary portion being adapted to fit within a cutout perforation extending through the flat main card portion.

U.S. Patent No. 3,855,033 discloses a method of making an embossable monolithic identification credit card having a protected photograph and/or signature thereon. The method comprises providing a metal plate having a portion cut out of it to insert the photograph, folding a data sheet containing heat reactive adhesive on its back side around the metal plate, the data sheet having identifying indicia thereon and a cut-out portion responding to the cut-out portion of the metal plate, inserting the assembled metal plate, photograph, and folded data sheet into a clear pouch consisting of two sheets of polyester each containing heat reactivatable adhesive on their inner surfaces, and applying heat and pressure to the assembly of materials to laminate the data sheet to both sides of the metal plate and to the edges of the photograph and the overlying pouch sheets to the data sheet over the photograph and identifying indicia, and with the pouch sheets adhered to one another on all four sides at its border whereby a monolithic identification credit card is provided which can be embossed with stable, raised indicia.

U.S. Patent No. 4,318,554 discloses a medical and/or informational identification credit card having multiple laminar parts partially heat-sealed in a localized area to permit high speed embossment in automatic equipment, whereupon a customized informational part, such as a microfilm chip or photograph, matched to the embossed identification on the partially laminated card may be inserted and locked in place by a full lamination of the card.

U.S. Patent No. 5,746,451 discloses an overlay for the front surfaces of a credit, debt, ATM, and similar transaction cards. The overlay is designed in such a manner that it allows the cardholder to customize the appearance of the front surface of the cardholder's cards

without affecting the operability of the card. The overlay may be easily fabricated with a number of designs, ranging from artistic designs, to personal photographs, to political, religious, humorous, or other messages. As such, the overlay allows a cardholder to customize and personalize the appearance of the cardholder's cards as well as to use the cards as a means to communicate ideas and messages in addition to acting as a means of payment whenever a card is issued.

U.S. Patent No. 6,224,109 discloses a credit card with driver's license for providing credit to an individual, information regarding the individual and proof of registration to operate a motor vehicle on a single form of identification. The credit card with driver's license includes a semi-rigid thin piece of material having a face side, a photograph of the individual positioned on the face side, additional identifying information positioned on the face side and a magnetic strip storing information providing access to credit of the individual and personal information regarding the individual upon reading of said magnetic strip by a credit card terminal. The credit card with driver's license is registered with a Department of Motor Vehicles in a state in which the owner resides and credit is provided by either an independent financial institution or the state government issuing the driver's license. The additional information includes at least one of a date of birth, height, weight, hair color, eye color, sex and an address of the owner printed on said face side. The credit card with driver's license may be laminated to provide additional protection against altering information thereon. A strip is also positioned on a back side thereof within which the individual places a signature for purposes of authentication when accessing credit provided by said credit card with driver's license.

U.S. Patent No. 5,774,168 discloses an identity card, especially a credit card, having a picture section, which contains a photo of the cardholder. In this section, pixels of different absorptions, especially the gray and black parts, are burned by a laser beam point-by-point into a surface layer and/or an intermediate layer located below a transparent surface layer of the identity card. In addition, a colored part is applied, particularly using the thermal transfer

process, which covers the same area as the image. Security features can also be introduced into the image division.

U.S. Patent No. 5,972,546 discloses the application of Lippmann photographs as a unique security device on security documents, such as e.g., identity cards, passports, credit cards. The recording of such photographs requires a special type of photosensitive film layer in contact with a reflecting layer. Panchromatic photopolymer materials can be used and, after being recorded and processed, laminated to security documents. Lippmann photographs are almost impossible to copy and, certainly, cannot be copied by conventional photography or color copying machines.

U.S. Patent Application Publication No. 2001/0005953 discloses a credit card-sized plastics display frame that defines a front rectangular opening and coplanar side grooves peripherally around this opening for receiving a photograph and a protective window in front thereof. The window being usable as a template to cut an appropriately sized photograph from a standard-sized picture for insertion in the display frame. The photograph and the window are installed in the frame by front loading through the rectangular opening. The rear wall of the frame defines panels which can be selectively, and reversibly, folded back to form a foot member to allow the frame to stand on a horizontal surface. A diamond-shaped cutout is defined in the rear wall to allow the display frame to be hung on a wall with a nail and to facilitate the removal of the photograph and window from the frame. The display frame is characterized by its universal credit card dimensions, the snap fit front loading mounting of the photographing window, the reversibly expendable support stands, by the diamond-shaped cutout, and a window which also acts as a template to down-size a standard picture to the required dimensions for the display frame.

Applicants' Claims are Patentable Over the References

Applicants' claims recite limitations that are not disclosed, taught, or suggested in the references discussed above. As an example, the references fail to disclose, teach, or suggest,

whether the references are considered alone or in combination with each other, “a recess operable to receive an item personally selected by a cardholder of the identification card to customize the identification card according to one or more particular personal preferences of the cardholder, the recess permitting the item to be inserted into and removed from the recess by the cardholder,” as recited in independent Claim 1. As another example, the references fail to disclose, teach, or suggest, whether the references are considered alone or in combination with each other, “a cavity in the identification card, the cavity being operable to receive an item personally selected by a cardholder of the identification card to customize the identification card according to one or more particular personal preferences of the cardholder; and a cover operable to secure the item in the cavity and operable to permit the item to be inserted into and removed from the cavity by the cardholder,” as recited in independent Claim 7.

As yet another example, the references fail to disclose, teach, or suggest, whether the references are considered alone or in combination with each other, “creating a recess within the body of the identification card, the recess being operable to receive an item personally selected by a cardholder of the identification card to customize the identification card according to one or more particular personal preferences of the cardholder; and covering the recess with a movable cover to secure the area bounded by the movable cover and the recess, the movable cover operable to secure the item in the recess and operable to permit the item to be inserted into and removed from the recess by the cardholder,” as recited in independent Claim 16. As yet another example, the references fail to disclose, teach, or suggest, whether the references are considered alone or in combination with each other, “a recess operable to receive an insert, the recess permitting the insert to be inserted into and removed from the recess by a cardholder of the identification card; and the insert coupleable to a picture to permit the picture to be inserted into and removed from the recess by the cardholder, the picture being personally selected by the cardholder to customize the identification card according to one or more particular personal preferences of the cardholder,” as recited in independent Claim 23.

Accordingly, for at least these reasons, Applicant's claims are patentable over the references discussed above.

Conclusion

Applicant respectfully requests, under 37 C.F.R. § 1.102(d), that this Application be granted special status. Enclosed is a check in the amount of \$130.00 for this Petition. Applicant believes that no further fees are due. Nonetheless, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicant



Jay B. Johnson
Reg. No. 38,193

Date: January 20, 2004

Correspondence Address:
Baker Botts L.L.P.
2001 Ross Avenue, Suite 600
Dallas, Texas 75201-2980
Tel. 214.953.6431

Customer Number: 05073